

Serial No. 10/632,561

Pre-Appeal Brief Request for Review

UTILITY PATENT

B&D No. JK01243

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: **Jaime GARCIA et al.**

Serial No.: **10/632,561**

Examiner: **C. Dexter**


Filed: **July 31, 2003**

Group Art Unit: **3724**

For: **OPTICAL ALIGNMENT SYSTEM**

Assistant Commissioner for Patents
Washington, DC 20231

PRE-APPEAL BRIEF REQUEST FOR REVIEW

I, Adan Ayala, Reg. No. 38,373, certify that this correspondence is being deposited with the U.S. Postal Service as first class mail in an envelope addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on 1-18-07 

Dear Sir:

This is in response to the final Office Action of November 30, 2006. A Notice of Appeal has been filed herewith.

Applicants request that the rejection in the present case be withdrawn.

Currently in the above-identified application therefore are Claims 21-25 and 35-41.

The Examiner has rejected Claim 35-36 under 35 USC § 103(a) as anticipated by US Patent No. 6,481,322 ("Hsiung"). Applicants request that such rejection be reversed as no motivation exists to modify Hsiung as suggested by the Examiner.

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so. *In re Kahn*, 441 F.3d 977, 986, 78 USPQ2d 1329, 1335 (Fed. Cir. 2006).

Claim 35 calls for a table saw comprising a support surface with an aperture therethrough,

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for supporting a workpiece, a beveling cutting device adjustably extending through the support surface aperture, said cutting device for cutting a workpiece, the cutting device being disposed in a plane, the cutting device having a rotational axis disposed below the support surface, and a beveling axis substantially perpendicular to the rotational axis, whereby operation of the cutting device in the workpiece results in the formation of a kerf having a first and a second side in the workpiece, a first optical emitting device adjustably coupled to the table saw and disposed above the support surface to project a first optical indicator substantially aligned with the plane, wherein the first optical emitting device is configured so as to bevel with the cutting device, such that said first optical indicator is projected to substantially indicate a cutting path of the cutting device along the workpiece.

In the present case, the Examiner has cited a miter saw reference against the claimed table saw. As admitted by the Examiner, the rotational axis of the cutting device (i.e., the blade) of the Hsiung miter saw is not disposed below the support surface, as found in table saws and called for in Claim 35. Instead, it shows the rotational axis to be disposed above the support surface, as found in miter saws.

The Examiner alleges that “it would have been an obvious matter of design choice to modify Hsiung by providing the rotational axis at, above or below the support surface since applicant has not disclosed that having the rotational axis at a specific location (i.e., below the support surface) solves any stated problem or is for any particular purpose and it appears that the saw would perform equally well with the rotational axis disposed at any vertical location relative to the support surface.” In effect, the Examiner is stating that it would have been “an obvious matter of design” to take the miter saw configuration and convert it into a table saw, because

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such saw “would perform equally well.” Such analysis however violates the Federal Circuit precedent and the MPEP requirements.

If a proposed modification renders the prior art invention being modified unsatisfactory for its intended purpose, then no suggestion or motivation exists to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984) (*quoted by* MPEP § 2143.01(V)). In the present case, the purpose of the Hsiung miter saw (and all miter saws) is to provide an accurate cut. Accordingly, the Hsiung miter saw would be used as follows: a user places workpiece 4 against the vertical fence and lowers the saw assembly (and thus blade 11) into contact with workpiece 4 for cutting. Because workpiece 4 is held firmly against the fence and the rotation of blade 11 pushes workpiece 4 into the fence, the workpiece 4 does not move during the cutting operation, providing for a very accurate cut.

However, if the rotational axis of blade 11 were to be disposed below the support surface as suggested by the Examiner, the user would not be able to lower the saw assembly (and thus blade 11) into contact. Furthermore, the rotation of blade 11 would move the workpiece away from the fence, allowing workpiece 4 to move and causing an inaccurate cut. Accordingly, because the suggested modification would render the Hsiung miter saw unsatisfactory for its intended purpose, then no suggestion or motivation can exist to make the proposed modification, under present Federal Circuit law.

Furthermore, if the proposed modification of the prior art changes the principle of operation of the prior art invention being modified, then no suggestion or motivation can exist to make the proposed modification. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959) (*quoted by* MPEP § 2143.01(VI)). As discussed above, the user would use the Hsiung miter saw by

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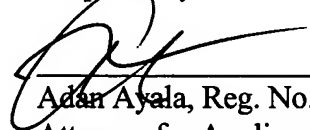
pushing the workpiece 4 against to the fence (to minimize movement of workpiece 4) and lowering the saw assembly (and blade 11) into contact with workpiece 4.

If Hsiung were to be converted into a table saw as suggested by the Examiner, the workpiece 4 would be moved and pushed into blade 11, as is standard table saw cutting practice.

Accordingly, the way the cutting operation is conducted is substantially modified, to the extent it changes the principle of operation of the miter saw. Therefore, no suggestion or motivation can exist to make the proposed modification.

Accordingly, Claims 35-36 should be allowed over Hsiung, and allowance the present application is respectfully requested.

Respectfully submitted,



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